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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,635

09/29/2004

Eberhard Ammermann

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04/25/2008

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

04/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/509,635	Applicant(s) AMMERMANN ET AL.	
	Examiner DANIELLE SULLIVAN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/27/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments, filed 01/27/2008, with respect to the rejection(s) of claim(s) 1-6 under 35 U.S.C. 112, second paragraph and the provisional rejection under obviousness-type double patenting have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the amendment filed 01/17/2008.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8 and 10 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Pees et al. (WO 98/46608).

Pees et al. disclose a fungicidal composition comprising a phytotoxic agrochemical in combination with kresoxim-methyl (abstract; page 17, lines 3-7 and 21). Kresoxim-methyl is Formula I wherein m is 0, Q is C(=N-OCH₃)-COOCH₃, A is -CH₂O-, B, B is phenyl and R^a is CH₃. The co-formulations comprises bactericides, herbicides, fungicides, insecticides (includes acaricides) and nematocides (page 18, lines 3-5). The compositions are used to treat plants, seed or medium (soil) (page 18, column 18-22). Although a method for increasing the resistance of plants to phytotoxicity is not specified it is inherent since Pees et al. disclose that the method is used to treat plants

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with the disclosed compounds. Thus, the resistance to phytotoxicity would be an inherent property of the disclosed invention.

In view of In re Best, Bolton and Shaw, 195 USPQ 430 (C.C.P.A. 1977), the mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claims drawn to those things to distinguish them over the prior art. Therefore, the method for increasing the resistance of plants to phytotoxicity is anticipated by Pees et al.

Claims 1-3, 6 and 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller et al. (US 6,159,992).

Muller et al. teaches a fungicidal mixture comprising Formula I wherein m is 0, Q is C(=N-OCH₃)-COOCH₃, A is -CH₂O-B, B is 5-membered heteroaryl (pyrazolyl or triazolyl) and R^a is phenyl and R^a is halogen (abstract). The formula is mixed with further active ingredients, such as fungicides, insecticides, arachnids, nematocides, herbicides, growth regulators or fertilizers (column 3, lines 5-10). The composition is used in a method for controlling fungi in plants (column 3, lines 11-24).

Although a method for increasing the resistance of plants to phytotoxicity is not specified it is inherent since Muller et al. disclose that the method is used to treat plants with the disclosed compounds. Thus, the resistance to phytotoxicity would be an inherent property of the disclosed invention.

In view of In re Best, Bolton and Shaw, 195 USPQ 430 (C.C.P.A. 1977), the mere recitation of a newly-discovered function or property, inherently possessed by

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things in prior art, does not cause claims drawn to those things to distinguish them over the prior art. Therefore, the method for increasing the resistance of plants to phytotoxicity is anticipated by Muller et al.

Claim Rejections - 35 USC § 103

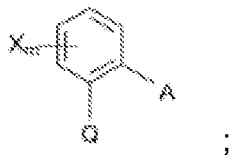
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al. (WO 98/46608), in view of Ernst et al. (US 6,541,425).

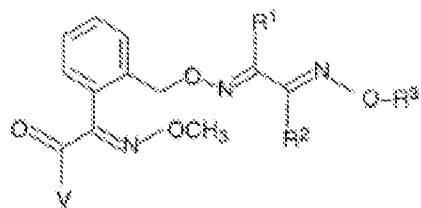
Applicant's Invention

Applicant claims a method of increasing the resistance of plants to the phytotoxicity of other crop protection products, which comprising treating the plants, the soil or seeds with an effective amount of a compound of formula I.



and wherein the compound of formula I is applied together with at least one phytotoxic agrochemical. Preferably, having the structure of formula II

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, in which V is OCH₃ or NHCH₃, R₂ is C(R')=NOR'', and R' and R'' is are C1-C4-alkyl.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Muller et al. teach a composition as discussed above in 102(b) rejection.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Muller et al. does not teach a composition of formula II. It is for this reason that Ernst et al. is added.

Ernst et al. teaches a fungicidally active compound of formula II wherein V is OCH₃ or NHCH₃; R₁ is hydrogen, cyano, C1-C4-alkyl, C1-C4-haloalkyl or C3-C6-cycloalkyl; R₂ is C(R')=NOR'', where R' is hydrogen, C1-C6-alkyl or C3-C6-cycloalkyl and R'' is hydrogen, ; and R₃ is C1-C10-alkyl, C2-C10-alkenyl, C2-C10-alkynyl or C3-C6-cycloalkyl (see Formula (II), column 10, line 35 thru column 12, line 28). These are fungicidally active strobilurins (column 10, lines 19-21).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Muller et al. and Ernst et al. to further include combining formula II as defined in claims 4 and 5 with the phytotoxic agrochemical disclosed by Pees et al. It would be prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in prior art.” In re Kerkhoven 206 USPQ 1069, 1073. Therefore, combining the fungicides as disclosed by Muller et al. with phytotoxic agrochemicals would be prima facie obvious to one of ordinary skill in the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nevill et al. (US 2002/0004457), Duvert (6,015,802 and 6,057,331) and Martin et al. (US 5,041,663).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIELLE SULLIVAN whose telephone number is (571)270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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